

RECEIVED  
CENTRAL FAX CENTER

MAY 15 2009

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. : 7,004,350 B2  
Applicant : OROUMIEH, Robert  
Serial No. : 10/801,194  
Filed : Mar. 15, 2004  
For :  
Assignee: Amity Rubberized Pen Co.  
Issued: Feb. 28, 2006  
DISPENSER FOR TOOTHPICKS AND TABLETS

REQUEST FOR STATUS ON PATENT OFFICE TO FOLLOW ITS OWN REGULATIONS AND REMOVE  
UNAUTHORIZED THIRD PARTY SUBMITTALS FROM PATENT FILE AND DISCARD THE UNAUTHORIZED  
THIRD PARTY SUBMITTALS

Dear Sir/Madam:

On March 25, 2009 I contacted the Patent Office to seek the status of Assignee's September 24, 2006 petition to correct inventorship and to enquire about unauthorized third party submittals which had been placed in the Patent File for the subject patent, U.S. Patent No. 7,004,350 ("the '350 Patent"). Mr. Gene Crawford, the supervisory patent examiner for the '350 Patent, indicated that the petition to correct inventorship had never been forwarded to his attention. Within days of calling Mr. Crawford, Assignee obtained a decision on the September 24, 2006 petition to correct inventorship. At the same time, Mr. Crawford indicated that all of the unauthorized third party submittals had been removed from the file for the '350 Patent. I confirmed this news by reviewing the '350 Patent file on the PAIR system on April 12, 2009. On May 11, 2009 I checked the '350 Patent file on the PAIR system and noticed that all of the previously removed third party submittals were inserted back into the file and another third party submittal was filed on April 23, 2009. Today, May 15, 2009, I checked PAIR again and find no change. To date, no action has been taken on these prohibited third party submittals, which have no standing under office rules and relevant case law.

The reappearance of these unauthorized third party submittals is a matter of great concern to Assignee. It has not been explained and nothing in writing has been posted or sent to Assignee to explain why the Patent Office is not following its own regulations regarding these unauthorized third

party submittals. Assignee requests that the Patent Office conduct a full and detailed investigation to determine how, why, and by whom, these documents were placed back in the Patent File, and requests that the Patent Office provide a written notice as to these actions so that proper responses can be made and so that Assignee can direct its questions to the appropriate person at the Patent Office.

As to those unauthorized third party submittals, Assignee respectfully requests again that they be removed from the Patent File and discarded pursuant to 37 C.F.R. § 1.322(a)(2)(ii) (“Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office.”). Assignee respectfully requests that this action be taken immediately and not wait for the outcome of any investigation or written notice.

Those submittals include the following:

1. An “opposition” to Assignee’s petition was filed on or about October 27, 2006 by third party Harris Cohen;
2. A “Supplemental Opposition” filed by the same third party on or about January 31, 2008;
3. A “Petition to Expunge Assignment Records in Issued Patent 7,004,350” filed again by the same third party on or about January 31, 2008;
4. A petition to correct inventorship to seek to add himself as an inventor to Assignee’s patent; and, most recently,
5. That same third party filed on April 23, 2009 a petition to expunge the certificate of correction that was issued for Assignee’s patent on March 30, 2009.

All of these third-party documents were filed by Harris Cohen through his attorney, William Breneman. Although these documents do not clearly state on the first page that Mr. Breneman is not representing any of the named inventors or the assignee, it should be stated here that Mr. Breneman does not, and never has, represented any of the named inventors, the assignee, nor any other entity of

record related to the '350 Patent. All of these third-party documents were filed and accepted by the Office and entered into the file of Assignee's issued patent against the office's own regulations. These third party submittals seek relief to which third parties are not entitled.

**Harris Cohen is a Third Party with No Ownership Interest in the '350 Patent**

Harris Cohen is a third party with no ownership interest in Assignee, nor Assignee's U.S. Patent No. 7,004,350. Additionally, Mr. Cohen is not an inventor, nor had he ever been named by Assignee or the other inventors as an inventor for Assignee's patent.

Third parties, such as Mr. Cohen, have no standing to demand that the Office issue or refuse to issue a Certificate of Correction. See MPEP 1480 I., 37 C.F.R. § 1.322(a)(2); see also *Hallmark Cards, Inc. v. Lehman*, 959 F. Supp. 539, 543-44, 42 U.S.P.Q.2d 1134, 1138 (D. D.C. 1997); see also *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc.*, 218 F.Supp.2d 1243, 1250-51 (S.D. Cal. 2002) ("Because the alleged infringer is not a necessary party to a claim for correction under § 256, the fact that it does not concur in the decision to correct a patent does not create a correction dispute under § 256."); *FFOC Co. v. Invent A.G.*, 882 F. Supp. 642, 650 (E.D. Mich. 1994).

Third party submittals, such as Mr. Cohen's filings regarding Assignee's patent, are not to be made of record in Assignee's patent file, nor retained by the Office. 37 C.F.R. § 1.322(a)(2)(ii). Instead of following its own procedures, the Office has made Mr. Cohen's third-party submittals of record in Assignee's patent file. Assignee requests again (after making the same request on March 25, 2009) that the Office again remove third-party submittals from its patent file, and that this time the Office discard the submittals so that they cannot be simply returned to the file a third time. Additionally, Assignee notes that MPEP §§ 503 and 1480 I. state that the Office will not correspond with third parties on whether the Office intends to issue a Certificate of Correction.

Lastly, Mr. Cohen claims, without authority, that he has standing under 35 U.S.C. 256 to dispute inventorship before the Patent Office. No interference has been announced in this matter, due to the failure of the Patent Office. In any case, Mr. Cohen is not a party to any dispute under 35 U.S.C. § 256. *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc.*, 218 F.Supp.2d at 1250-51.

**February 24, 2009 Cohen Petition to Correct Inventorship**

Mr. Cohen filed a "Petition to Correct Inventorship in an Issued Patent Pursuant to 37 CFR 1.324 and 35 U.S.C. § 256" on or about February 24, 2009 to have his name added to the inventors listed on Assignee's patent. As stated above, Mr. Cohen is not an inventor for Assignee's patent and he has no ownership rights or title to Assignee's patent. Additionally, his petition does not comply with 35 U.S.C. § 256 nor Office regulations.

35 U.S.C. § 256 requires that the Office may issue a certificate of correction of inventorship on "application of all the parties and assignees." Mr. Cohen's petition fails to even assert agreement by Assignee or the other inventors to his petition.

Mr. Cohen's petition to correct Assignee's patent also violates 37 C.F.R. § 1.324(b)(2) because Mr. Cohen failed to include a statement from the current named inventors, Robert Oroumieh and Mary Lewis, that states agreement to the proposed change in inventorship or stating no disagreement to the requested change. Mr. Cohen's petition is also defective under 37 C.F.R. § 1.324(b)(3) for failing to include the required statement from the Assignee, Amity Rubberized Pen Company.

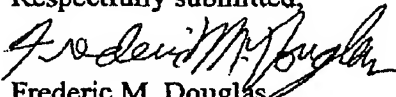
Thus, Mr. Cohen's petition to correct inventorship does not comply with the Office's regulations. On April 23, 2009 Mr. Cohen filed a petition to suspend the Office's rules under 37 C.F.R. § 11.3. However, even if Mr. Cohen had standing to submit such a petition, it is defective as 37 C.F.R. § 11.3 does not permit suspension of rules which are a requirement of statute. 35 U.S.C. §

256 requires that Mr. Cohen submit his petition with an "application of all the parties and assignees."

Thus, Mr. Cohen cannot obtain suspension or waiver of the Office's regulation in this regard.

Dated: May 15, 2009

Respectfully submitted,



Frederic M. Douglas  
Patent Office Reg. No. 48,813  
Attorney of Record for Assignee  
(949) 293-0442

///  
///